

herbicide, a herbicide, and a pesticide, said agricultural solids having particles more than about 99 wt.% passable through a Tyler #48 sieve;

- b. a single non-ionic surfactant selected from the group consisting of alkyl-phenoxy-poly(ethylenoxide)alkanols, ethoxylated aliphatic C<sub>11</sub> to C<sub>15</sub> alcohols, ethylene oxide-propylene oxide block copolymers and ethoxylated fatty acids;
- c. a water-soluble glycol liquid consisting of at least one member of the group consisting of ethylene glycol, and propylene glycol; and
- d. methylthio- $\alpha$ -hydroxybutyric acid.

In the previous Office Action, the Examiner asserted that he does not believe that all materials falling within the category of claim 1's listing of fertilizers, adjuvants, herbicides, and pesticides of component (a), would possess chemical and physical properties that would allow for the production of a stable solid suspension once combined with the components of (b), (c), and (d). However, the Examiner provided no prior art and no factual basis for his assertions. In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure. It is again submitted that the Examiner has not met this initial burden. Applicants urge that the claimed groupings of fertilizers, adjuvants, herbicides and pesticides are each generically useful components of the presently claimed suspensions. The principal inquiry to be undertaken when examining the question of whether the enablement requirement has been satisfied is whether the scope of enablement provided by the application is commensurate with the scope of the invention set forth in the claims. See, e.g., *In re Cescon*, 474 F.2d 1331, 177 USPQ 265 (CCPA 1973). The USPTO has historically considered it necessary to provide a broad scope of enablement by providing specific embodiments of the invention falling within the scope of the claims. In the case of *In re Robins*, 429 F.2d 452, 166 USPQ 552 (CCPA 1970) the court held that the mere listing

of specific compounds, chemical substituents, solvents, cross-linking agents, etc. in the specification would in most cases provide evidence of enablement equivalent to that previously required in the nature of specific working examples using each of the various components. See *In re Stephens*, 529 F.2d 1343, 188 USPQ 659 (CCPA 1976). Applicants submit that the listing of specific materials and their purposes in the specification, including herbicides, adjuvants, fertilizers, and pesticides are described in such a way that one of ordinary skill in the art would readily ascertain how to make and use the claimed suspensions without undue experimentation.

Furthermore, it should be noted that the present claims relate only the *stable agricultural solids suspensions* which are formed from the disclosed components, and not to any materials which might hypothetically fail to qualify as stable solid suspensions. Thus, any material which the Examiner envisions as failing to allow for the production of a stable solid suspension *would not* fall within the scope of useful agricultural solids according to the present invention.

It is submitted that no factual assertions *whatsoever* have been made by the Examiner to show that any of the claimed agricultural solids materials would be unsatisfactory in the formation of the claimed suspensions. Accordingly, despite the examiner's refusal, Applicants again call on the Examiner to provide an affidavit under 37 C.F.R. 1.04(d)(2), attesting to any facts to his knowledge which were relied upon in his concluding that the present claims lack enablement. It should be noted that, by regulation, such an affidavit *must* be provided when called on by Applicant. Mere arguments are not sufficient in response to an Applicant's request for an affidavit under 37 C.F.R. 1.04(d)(2).

The Examiner now asserts in page 4 of his response that claims 1-9 are not rejected as "lacking" enablement, but rather that there is an issue with *scope* of enablement. The Examiner uses this reasoning to support the position that he is not required to provide any reference to support his assertions of enablement. However, page 2 of his response clearly states his position that the specification "does not reasonably provide enablement"

for the claimed invention. He goes on to assert that the specification "does not enable" one skilled in the art to make and use the invention. Thus, it would be reasonably inferred by Applicants that the Examiner has indeed rejected these claims for *lacking* enablement, and that the Examiner must provide an affidavit under 37 CFR 1.04(d)(2) to support his assertions. Should the Examiner continue to take the position that the present issue relates only to a *scope* issue of enablement, where certain embodiments of the invention are enabled, and certain embodiments are *not* enabled, Applicants call on the Examiner to provide scientific evidence as to why he considers certain embodiments *not* to be enabled by the present disclosure. It is submitted that the Examiner's blanket statement that "not all" agricultural compositions would work in accordance with the invention is not based in scientific fact, but on speculation. The Examiner claims to rely on knowledge from "any organic chemistry textbook" in making his conclusion. However, Applicants call on the Examiner to provide a scientific evidence in any such textbook for his assertion that it is "more than likely" that many agricultural solids to be used in part (a) of claim 1 *would not* interact with the ingredients of parts (b)-(d). Applicants respectfully urge that when making a determination of lack of enablement, the Examiner should never make the determination based on personal opinion. MPEP 2164.05.

The relevant case law has held that the disclosure of invention set forth by an applicant in his application must be given the presumption of correctness and operativeness by the PTO and that the only relevant concern of the PTO under the circumstances should concern the truth of the assertions contained in the application.

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of S112 unless there is reason to doubt the objective truth of the statement contained therein which must be relied on for enabling support ... In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own

with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1967). See also *in re Bowen*, 492 F.2d 859, 181 USPQ 48 (CCPA 1974).

The PTO Board of Appeals has adopted the standard established by the CCPA in *Marzocchi*. See, e.g., *Ex parte Laiderman*, 175 USPQ 757 (POBA 1971) and *Ex parte Kenage*, 190 USPQ 346 (POBA 1976). Thus, as a matter of law, it must be believed that Applicant's disclosure is enabling. The Examiner has not provided a factual showing to prove otherwise.

It is respectfully asserted that one skilled in the art would be entirely capable of making and using the claimed suspensions with no undue experimentation being required. "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied." MPEP § 2164.01(b). See also *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (the scope of enablement must only bear a "reasonable correlation" to the scope of the claims). It is submitted that the present Examples *clearly* provide sufficient enablement for making the suspensions of the present claims.

Applicants take note of the Examiner's statements on page 5 of his reply, where he states that a *burden of experimentation* would lie on those skilled in the art to determine which of supposedly "millions" of agrichemicals would formulate into a solid stable suspension. It is urged that one skilled in the art would not be required to take on the burden of experimenting with "millions" of chemicals as the Examiner suggests. Rather, if any experiments were to be conducted, they would clearly only involve a limited number of trials necessary to achieve a particular goal. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). Even if some degree of experimentation were to be conducted, such experimentation may not be undue if the

skilled artisan is given sufficient direction or guidance.” *In re Colianni*, 561 F.2d 220, 224, 195 USPQ 150, 153 (CCPA 1977). It is asserted that the present specification provides ample guidance for carrying out the presently claimed invention, despite the fact that each and every possible embodiment of the invention is not specified in complete detail. It is urged that the specification is sufficiently enabling such that no undue experimentation would be necessary for one skilled in the art to choose agricultural solid materials in accordance with part (a) of claim 1.

Applicants again point out that the Examiner has previously determined that claim 1 is allowable, in the Office Action mailed October 3, 2005. Applicants therefore submit that the Examiner must have therefore considered these claims, in and of themselves, as being sufficiently enabling for one of ordinary skill in the art to make and use the invention as claimed, without undue experimentation.

The examiner has cited the text Roberts, et al, Basic Principles of Organic Chemistry, 2<sup>nd</sup> Edition, W.A. Benjamin, Inc. 1977 and 1984 to support his position. Since this is non-patent literature, it is requested that the examiner provide the Applicant with copies of the pages of this reference on which he relies.

Notwithstanding the fact that different agricultural chemicals vary in chemical and physical properties, this in and of itself is insufficient to for a lack of enablement rejection. It should be noted that not all agricultural chemicals fall within (a) of the instant claims. The claims require agricultural solids consisting essentially of at least one member selected from the group consisting of a fertilizer, a combination of an adjuvant and a herbicide, a herbicide, and a pesticide. Further said agricultural solids having particles more than about 99 wt.% passable through a Tyler #48 sieve. The examiner has provided no cogent scientific reasoning to support a legally viable position of non-enablement. A broad-brush assertion of differing properties is simply insufficient. For the foregoing reasons, it is respectfully urged that the rejections of claims 1-9 under 35 U.S.C. 112, first paragraph, should be withdrawn.

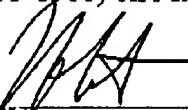
The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office (FAX No. (571) 273-8300) on May 25, 2007.



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